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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,049	12/07/1999	SHMUEL SHAFFER	99P7399US	7243

7590 12/30/2002
SIEMENS CORPORATION
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

NGUYEN, QUYNH H

ART UNIT PAPER NUMBER

2642

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/457,049

Applicant(s)

SHAFFER ET AL.

Examiner

Quynh H Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

In claim 1, it is unclear to where a message via a first contact method is sending.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1-3, 6, 21-23, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808).

Referring to claim 1, Wood teaches the steps of: providing a contact list (Abstract, lines 4-5); and upon receiving a request the telephone connection message, referring to said contact list (col. 1, lines 11-13), where the first contact method is via “network (web)” and the second contact method is via “telephone switch 16 (central office, PSTN, or a PBX...)”, a response to the telephone connection message from the network (web) to a web browser and attempt to reach the called party (col. 2, lines 13-16).

Wood does not teach a method to locate the called party but rather the method of making a telephone connection facilitating the computer network facility to a telephone switch via a switch computer interface, in response to which the switch sets up the desired telephone connection to the called party in the same manner as if the called party number had been dialed by the subscriber at the telephone.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method for providing telephone call control and information as described in Wood for locating the called party in order to have a complete and sufficient system.

Referring to claims 2 and 3, Wood teaches contact list manager comprises: one or more contact methods for each contact; and one or more rules applicable to contacts and contact methods regarding when or how to send a locator request one or more contact methods is one or more methods selected from the group consisting of one or more telephone numbers (col. 9, lines 46-57).

Claim 16 is rejected for the same reasons as discussed above with respect to claim 1, and Wood teaches the first destination is the “network (web)” and the second destination is the “telephone switch 16 (central office, PSTN, or a PBX...)” reads on claimed “the first and second destinations are of different multimedia types”.

Referring to claim 21, Wood teaches the second contact method telephone number is entered in full (col. 2, lines 24-25).

Referring to claim 22, Wood teaches the first contact method is via network (web) reads on claimed “the first contact method includes an e-mail address”.

Referring to claim 23, Wood teaches automatically extracting the second contact method from the response (col. 2, lines 13-16).

Referring to claim 26, Wood teaches recording and playing the response for the caller (col. 10, lines 34-43).

Referring to claim 27, Wood teaches using first contact method via network (web) and second contact method via “telephone switch” to make a telephone connection

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between the calling and called party reads on claimed “concurrently sending messages to each of at least two contacts of the two or more contacts in response to a single request to locate a called party”.

4. Claims 4, 17-20, 28, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808) in view of Brennan et al. (U.S. Patent 5,329,578).

Referring to claim 4, Wood does not teach contact list database stores additional contact information designating the conditions for usage of the contacts or the contact methods.

Brennan teaches contact list database stores additional contact information designating the conditions for usage (Table 4.0 and col. 7, lines 47-60) of the contacts or the contact methods.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a list of contact information designating the conditions for usage in order to provide special treatment for urgency calls.

Referring to claim 17, Brennan teaches one or more contact lists (Table 5.0) associated with one or more called parties; and one or more rule sets (col. 7, lines 47-50) associated with one or more called parties.

Referring to claim 18, Brennan teaches one or more system or group contact lists (Table 2.0, other devices) providing contacts that are applicable to more than one called party; and one or more system or group rule sets (Table 4.0, entries under Day & Time) applicable to more than one called party.

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Referring to claim 19, Brennan teaches an interface for receiving one or more responses (col. 10, lines 34-43) to location requests; and a presentation module (col. 13, line 68 through col. 14, line 3) for presenting responses to a caller.

Claim 20 is rejected for the same reasons as discussed above with respect to claim 6.

Claim 28 is rejected for the same reasons as discussed with respect to claim 6.

Referring to claim 33, Wood teaches communicating the telephone connection message using the web browser reads on claimed “the first and second contact methods is an address for text-based messaging”.

5. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808) in view of Cheston, III et al. (U.S. Patent 6,330,308).

Referring to claim 24, Wood does not teach the first contact method is a telephone number, the second contact method is a telephone number spoken verbally by a responding party via telephone, and said automatically extracting said second contact method from the response includes using speech recognition software to extract the second contact method.

Cheston, III teaches an automated directory assistance system to obtain called party telephone number from a directory assistance system using speech recognition capabilities. The directory service system retrieves the number for the destination (col. 7, lines 20-33) reads on claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine voice recognition system for automatically extracting the

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second contact method into the system to locate the called party to provide a diversity system with a wide variety of options for locating the called party.

6. Claims 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808) in view of Herbst (U.S. Patent 4,941,170).

Referring to claim 25, Wood does not teach the automatically processing the response comprises automatically extracting the second contact method using optical recognition software.

Herbst teaches a facsimile transmissions system that decodes a mark sense cover sheet facsimile data to be accessed by numerous conventional facsimile machines with no specialize adaptations to the facsimile machines. Also no modifications need to be made to the electronic mail system; the facsimile controller is programmed to provide it with the sender identity an destination address as needed by the electronic mail system reads on claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that one possible way to automatically extracting the second contact method is using optical recognition software.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,091,808) in view of Brennan et al. (U.S. Patent 5,329,578) and further in view of Kugell et al. (U.S. Patent 5,802,160).

Referring to claim 5, Brennan et al. teaches automatic attempting to locate said called party comprises: automatically sending one or more messages (Table 4.0, treatment and col. 7, lines 58-60) to parties listed in a contact list requesting location information (Table 4.0, day, time, treatment) regarding said called party, receiving

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responses to said one or more messages and presenting a response to a calling party (col.13, line 63 through col. 14, line 5).

Wood and Brennan do not teach canceling outstanding messages when a response is received.

Kugell teaches a method and system for providing telephone service wherein a plurality of telephone numbers are simultaneously signaled to allow a calling party to find a called party and after the signaling at at least one of the plurality numbers is terminated, others would stop ringing read on claimed "canceling outstanding messages when a response is received".

It would have been obvious to one of ordinary skill in the art at the time the invention was made to cancel outstanding contact messages once the party of interest has been located to save the system's resources allocation.

8. Claims 6, 8-15, 29-32, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kugell et al. (U.S. Patent 5,802,160) in view of Brennan et al. (U.S. Patent 5,329,578).

Claim 6 is rejected for the same reasons as discussed above with respect to claim 5; and Kugell does not teach the method for locating a called party.

Brennan teaches the method for locating a called party.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method for locating the called party as described in Kugell system in order to have a complete and sufficient system.

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Referring to claim 8, Brennan teaches receiving responses to said one or more messages and presenting a response to a calling party (col.13, line 63 through col. 14, line 5).

Referring to claim 9, Brennan teaches a called party is identified and identities of called parties (Table 4.0, Day and Time) are used in part to determine system behavior (Table 4.0, Treatment and Urgency).

Referring to claim 10, Brennan teaches called party may configure system behavior for a calling party (col. 4, line 67 through col. 5, line 2 and Table 1.0).

Referring to claim 11, Brennan teaches messages are predetermined prior to receiving said request (col. 10, lines 37-48).

Referring to claim 12, Brennan teaches the prompt play back unit and these prompts are usually the ones provide by the service provider with information regarding the called party (col. 10, lines 34-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made that the parties on the contact list may also submit responses to the messages with information regarding the called party.

Referring to claim 13, Brennan teaches the calling party is automatically notified of said responses (col. 10, lines 34-37), responses contain a contact method for reaching the called party (col. 6, lines 42-45), the last limitation is rejected for the same reasons as claim 6.

Referring to claims 14 and 15 are rejected for the same reasons as discussed above with respect to claim 13.

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Claim 29 is rejected for the same reasons as discussed above with respect to claim 16 and Brennan teaches the address is verbally entered by a responding party to indicate the location of the called party (col. 10, lines 34-43).

Claims 30 and 35 are rejected for the same reasons as discussed above with respect to claim 33.

Claim 31 is rejected for the same reasons as discussed above with respect to claims 24 and 25.

Claim 32 is rejected for the same reasons as discussed above with respect to claim 23.

Claim 34 is rejected for the same reasons as discussed above with respect to claims 6 and 29.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kugell et al. (U.S. Patent 5,802,160) in view of Brennan et al. (U.S. Patent 5,329,578) and further in view of Will (U.S. Patent 5,905,789).

Referring to claim 7, Kugell and Brennan do not teach allowing a called party to configure contact list.

Will teaches called party can configure contact list (col. 4, lines 54-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to let user create/configure contact list in order to suit his/her needs.

Response to Arguments

10. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry,

please

label the response "EXPEDITED PROCEDURE")

or: (703) 308-6296, (for informal or draft communication, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal

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Drive, Arlington, VA, Sixth Floor (Receptionist).


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 703-305-5451. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

qhn

Quynh H. Nguyen
December 19, 2002


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600